

I. Remarks

Claims 1-34 are pending and have been rejected in the Office Action. Claim 13 has been cancelled and the aspects previously in claim 13 have been rewritten into claim 1. Claim 14 has been amended to reflect the cancellation of claim 13. In view of the matters set forth below, it is believed that the rejections should be withdrawn and a notice of allowance should be issued.

II. Matters related to claim amendments

As noted above, claim 13 has been cancelled and the features previously set forth in that claim have been included in claim 1. Therefore, Applicants will first address the rejection related to previous claims 13 and 14.

A. Rejection of previous claims 13 and 14

Previous claim 13, which is now claim 1, was rejected in the Office Action in view of U.S. Patent No. 6,305,546 to Saunders *et al.* ("Saunders") taken in combination with U.S. Patent No. 6,575,330 to Rousselet ("Rousselet"). Specifically, the Office Action states:

With respect to claim 13, Saunders does not disclose that the resealable vent comprises a hinged vent panel integrally formed in the lid and secured to the lid at the lid's periphery. However, Rousselet discloses a hinged panel integrally formed in the lid and secured to the lids at the lids's periphery (Rousselet Fig 1 reference number 32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the lid of Saunders to include an integrally formed hinged panel at the periphery, as taught by Rousselet, for the purpose of creating a more convenient sealing means for the resealable vent.

Office Action at pages 5-6.

It is without question that in order to present a proper *prima facie* case of obviousness, the rejection must expressly state a factually supportable motivation to combine the references. Only then do Applicants need to set forth evidence to rebut the basis of the obviousness rejection. The requirement of a *prima facie* case of obviousness first be presented exists to prevent the Patent Office from using hindsight reasoning to reject Applicants' claimed invention.

In the above quoted rejection, the required motivation is clearly absent. That is, the rejection provides a technical aspect of each of Saunders and Rousselet. After

combining these features to allegedly provide the claimed invention, the rejection states that it would have been obvious to combine these feature because it would have been “more convenient” to do so. In the reasoning of the rejection, the motivation results from the combination of the features of the two references. This is indisputably hindsight reasoning and, as such, the rejection is improper.

To the extent that it would be contended that convenience would suffice as a motivation, the Examiner is reminded that rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). In making such a rejection, the Examiner must first and foremost supply the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstructions to supply the missing aspects of the invention. *Id.*

The contention that claim 13 is obvious is not supported by facts but, rather is a conclusory rejection based on the alleged “convenience” of the combination of features in the claimed invention. This rejection is effectively a *per se* rule of obviousness because the basis of the rejection is that the invention is obvious because it is another way to obtain the container of Saunders. Such rules are legally erroneous because they sidestep the fact intensive inquiry required by § 103. *See In re Ochiai*, 71 F.3d 1565, 1571 (Fed. Cir. 1995). Therefore, the rejection of claim 13 is improper for at least this reason.

Further, the Examiner provides no support for the allegation that the integral hinge feature would be “more convenient.” More convenient for whom? Consumers might actually like the venting feature of Saunders, but Applicants desired to make an alternate design for other, non-specified reasons. In sum, the alleged motivation of convenience is nothing other than unfounded speculation.

With regard to claim 14, since this claim is dependent from claim 13, it necessarily includes all of the features of claim 13. Therefore, the insufficiencies of the rejection of claim 13 apply equally to the rejection of claim 14. This rejection should be withdrawn along with the rejection of claim 13.

B. Rejections in view of Saunders taken alone

Claims 1, 2 and 6 were rejected under 35 U.S.C. is § 102(b) as allegedly being anticipated by Saunders. As acknowledged in the Office Action, Saunders does not

disclose the integral hinge feature that is now part of every recited. As such, the anticipation rejection has been mooted by the amendment of claim 1.

C. Rejections in view of Saunders taken with other references

Claims 3, 5 and 7-12 were rejected under 35. U.S.C. § 103(a) as allegedly being unpatentable over Saunders as applied to claim 1¹ and further in view of U.S. Patent No. 6,938,768 to Ferretti *et al.* ("Ferretti"). Claim 4 was rejected under § 103(a) as being unpatentable over Saunders, in view of Ferretti as applied to claims 1,2 and 3 and in the immediately previous obvious rejection and further in view of U.S. Patent No. 4,615,928 to Kawaguchi. Claims 15-17 were rejected under § 103(a) over Saunders and Rousselet as applied to claims 1, 13 and 14. Claims 18-21 and 26-34 were rejected under § 103(a) over Saunders as applied to claim 1 and further in view of U.S. Patent No. 6,845,877 to Diesterbeck ("Diesterbeck"). Claims 22-25 were rejected under § 103(a) over Saunders and Diesterbeck as applied to claims 1, 18 and 21 and further in view of U.S. Patent No. 5,730,309 to Jiradejnunt.

None of these references discloses the integral hinge feature that is now recited in claim 1 and those claims dependent thereon. Accordingly, the rejections based on the above stated combinations of Saunders with one or more other references have been mooted by the amendment of claim 1.

D. The claims are allowable in view of the prior art of record

Since the features of claim 13 are now set forth in claim 1, amended claim 1 was present in the claims of record when the first Office Action was issued. As such, the amendments presented herewith cannot give rise to a final rejection. Further, the additional prior art submitted herewith does not render the present invention obvious, either taken alone or in combination with one or more additional references. Accordingly, it is respectfully stated that the claims are allowable.

III. Conclusion

For the above reasons, it is respectfully stated that the invention is allowable as presently claimed. No fees in addition to the Request for One Month Extension of Time and Supplemental Information Disclosure Statement fees are believed to be due at this

¹ Since Saunders was not applied by itself in an obviousness rejection, it is understood that the reference to claim 1 is in relation to the application of Saunders in the anticipation rejection.

time. If any further fee is due, authorization to charge Deposit Account No. 50-0674 is included herewith.

Respectfully submitted,

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